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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,819	12/27/2001	Allan Tanghoj	P67397US0	2805
136	7590	11/04/2004	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			MAIORINO, ROZ	
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/026,819

Applicant(s)

TANGHOJ ET AL.

Examiner

Roz Maiorino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-68 and 70-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/04, 3/04, 6/02
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 2, 5,-6, 8-15, 17-20, 24-25, 30-31, 35-40, 42,-59, 61, 65-66, 69, 76-79.

DETAILED ACTION

Election/Restrictions

1. Claims 2, 5,-6, 8-15, 17-20, 24-25, 30-31, 35-40, 42,-59, 61, 65-66, 69, 76-79 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species , there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/30/2004.

Claim Objections

2. Claims 3 and 16 objected to because of the following informalities: claim 3 recites "the hose (for a friction reducing substance)." Line 6, its not clear if the applicant is claiming the limitation in the parentheses, if the applicant's intention are to claim the parenthetical then he should remove the parentheses. If the applicant intention is not to claim the parenthetical then he should completely eliminate the language form he claim. Claim 16 recites " such as 0%, such as 10%, such as 20%, such as 30%..." In lines 5-7, it's not clear what the applicant is trying to claim by such limitation. The specification has identical language and did not aid in the interpretation of the applicant's intentions. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3, 4, 7, 16, 21-23, 26, 28-29, 32-34, 60, 62-64, 67, 70-72 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent NO. 6602244 to Kavanagh et al.

Kavanagh teaches a urinary catheter 15 defining a conduit and having a proximal end and a distal end, a catheter package 11 having a hose with a cavity to accommodation of the catheter and in the proximal end a catheter outlet adapted to dismantle the proximal end of the catheter from the catheter package, sealing means (figures 3-6) to provide a substantially liquid tight seal between the catheter package and the urinary catheter while the catheter is being dismantled; While in the catheter is treated with lubricants.

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4. Claims 1, 41, 60 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent NO. 4850350 to Jackson.

Jackson teaches a catheter 4 defining a conduit and having a proximal end and a distal end, a catheter package 12 having a hose with a cavity to accommodation of the catheter and in the proximal end a catheter outlet adapted to dismantle the proximal end of the catheter from the catheter package, sealing means (figures 14-16) to provide a substantially liquid tight seal between the catheter package and the catheter while the catheter is being dismantled; wherein the package is being closed in the proximal end by a detachable closure. (figure 14)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 27, 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent NO. 6602244 to Kavanagh et al. as applied to claim1 above, and further in view of US Pub No. 2004/0158231 to Tanghoj et al or US Pub No. 2004/0153051 to Israelsson et al.

As mentioned above Kavanagh teaches the invention, except for the catheter being treated with a water base solution for treatment of a hydrophilic catheter. Both Israelsoon and Tanghoj teaches a catheter being treated with a water base solution for treatment of a hydrophilic catheter.

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Therefore it would have been obvious to one having ordinary skill in the art at time the invention was made to use a water base solution for treatment of a hydrophilic catheter for lubrication because Kavanagh already teach a lubricated catheter hence it would be obvious to use a water base solution for treatment of a hydrophilic instead of a lubricant to reduce friction of the catheter since both lubricant and hydrophilic serve the same purpose.

Double Patenting

6. Claim 1, 3, 4, 7, 16, 21-23, 26-29, 32-34, 60, 62-64, 67, 70-72 provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of copending Application No. 10/482229 and claims 1-87 of copending Application No. 10/183984. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roz Maiorino whose telephone number is 703-305-2336. The examiner can normally be reached on 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 703-308-2698. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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